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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/095,842 06/11/98 ARAKI

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IM51/0227

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EXAMINER

SZEKELY, P

ART UNIT

PAPER NUMBER

1714

DATE MAILED:

02/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/095,842

Applicant(s)

Araki, et al

Examiner

Szekely

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on 1/17/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 6-12 is/are pending in the application.  
Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 6-12 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☒ received in Application No. (Series Code/Serial Number) 08/612,865
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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### DETAILED ACTION

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 6-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As it was stated already in Paper #16, the specification recites on page 3, lines 6-12, the following: "when the flourine containing surfactant is used solely and if its amount is not more than 1% by weight, there cannot be obtained a particle size of not more than 200 nm, if the solid content is assumed to be 30 to 50% by weight." Page 4, lines 13-21 of the specification reads: "It is possible in the present invention that in the known emulsion polymerization system, notwithstanding that the solid content is as high as 30 to 50% by weight, the particle size can be decreased to not more than 200 nm by adding a nonionic non-fluorine-containing surfactant in a trace amount of 0.001 to 0.1% by weight on the basis of water in the presence of a small amount of a fluorine-containing surfactant, i.e. not more than 1% by weight , on the basis of water." On page 6, lines 25-37 the following paragraph can be found: "In order to prepare the aqueous dispersion which comprises the VdF polymer having a particle size not more than 200 nm and contains solids in an amount of 30 to 50% by weight , it is usually necessary to use a large amount of fluorine containing surfactant. However according to the preparation process of the present

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invention, it is possible to decrease the amount of the fluorine-containing surfactant to a small amount of not more than 1% by weight by adding a trace amount of the nonionic non-fluorine-containing surfactant. Namely, a small particle size of not more than 200 nm can be attained by adding the nonionic non-fluorine-containing surfactant". These quotations clearly show, that according to applicants' own specification, the composition claimed in claims 6-12 cannot be made, unless a nonionic non-fluorine-containing surfactant is also used, which means that it has to be present in the claimed composition. In other words, the composition as claimed cannot be made..

3. Claims 6-11 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The nonionic non-fluorine-containing surfactant is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The specification, as cited in the previous paragraph, clearly states, that unless the nonionic non-fluorine-containing surfactant is present, the claimed composition cannot be manufactured.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 6-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Blaise et al. 4,025,709.

Blaise et al. teach the use of 2.4, 1.2 and 0.6 grams of fluorinated emulsifier in 2 liters of water and a latex containing 35% solids. The emulsifier can be the sodium salt of perfluorooctanoic acid. See the Examples. The claimed particle size is inherent in the process and the composition. Applicants' claims are not novel. In the alternative the Examiner takes official notice that using the ammonium salt of an acid instead of the sodium salt is obvious if better solubility in water is desired and so is adding a colorant to a composition.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (703) 308-2460. The examiner can normally be reached on Tuesday through Friday from 7:00 a. m. to 5:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599 or (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Peter Szekely

Primary Examiner

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